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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/501,141
Filing Date: July 13, 2004
Appellant(s): MANSFIELD JR., RICHARD B.

Richard Neifeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/27/2009 appealing from the Office action mailed 12/02/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-58 are in this proceeding.

Claims 1, 2, 4, 6-9, 11, 24-51 are canceled.

Claims 3, 5, 10, 12-23, and 52-58 are pending.

Claims 3, 5, 10, 12-23, and 52-58 are rejected and appealed.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. It is noted however that the Abreu reference is US 20010056359; appellant mistakenly listed Knegendorf et al's PG PUB number by accident.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20030074272	Knegendorf, et al	4-2003
20010056359	Abreu	12-2001

Gilje, Shelby, "Jugs, Pans Pose a Lead Hazard," Seattle Times, Third Edition, June 25, 1986, pg C7.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3, 5, 10, 12-23, 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knegendorf et al (US20030074272) in view of Abreu (20010056359) and Official Notice.

Regarding claims 3, 12, 55, Knegendorf et al teaches an automated online system for matching recall specifications with registered consumers [abstract, 0054,

0072]. Knegendorf et al does not teach that a consumer's actual purchase history is used as part of the way to match users to new recalls. However, Abreu teaches that users are identified at the POS and product identifiers for each purchase are electronically tracked so that if a recall for that particular product is identified/crated, the user can easily be associated with the recall and notified [0171]. It would have been obvious to one of ordinary skill at the time of the invention to have identified and tracked which consumers purchase which products so that when a recall is needed, the consumers who have purchased the affected product may be easily notified.

Knegendorf et al teaches that consumers may be notified of the recall information in various ways including by sending relevant recall information to the consumer's email address [0054] or the users may access the system to acquire recall information by telephone [0055], by logging into a personalized portal user interface [0053] or "in-person" access [0059]. Knegendorf et al does not appear to explicitly mention a terminal or kiosk of a retail store computer system, yet it would have been obvious to one of ordinary skill at the time of the invention to have provided in-store kiosks and/or terminals for consumers to access the system so that consumers without a home computer can access the recall information, or so that any consumer can check recall information while they are in the store. Knegendorf et al teaches that product recalls have been known to typically include exchange for a safer version of the product, or monetary compensation [0004], but Knegendorf et al does not explicitly state rebate or discount incentive options. However Official Notice is taken that it is notoriously well known that consumers who purchase recalled products were typically compensated

with vouchers (discount incentives) good for future purchase of a similar (yet safe) product or rebates refunding consumers for money spent on replacement (safe) versions of the product. One such example can be found in "Gilje, Shelby, "Jugs, Pans Pose a Lead Hazard," Seattle Times, Third Edition, June 25, 1986, pg C7." In it, it is taught that merchandise vouchers for defective items (a pan and a jug) were provided to customers who purchased either defective item. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a voucher good for a new version of the defective product, so that customers of Knegendorf et al/Abreu could be assisted in the purchase of a replacement (safe) item. It would have been further obvious to one of ordinary skill at the time of the invention to have offered any of such typical restitution option within the automated recall system of Knegendorf et al in view of Abreu so that consumers can be fairly made whole for the recalled product – either by known rebate techniques or discount voucher techniques.

Regarding claim 5, Abreu teaches the use of UPC codes and it would have been obvious to one of ordinary skill at the time of the invention to have used UPC codes to identify particular products.

Regarding claim 10, properly notifying a user about a recall and the requisite fulfillment is taken to include inclusion of a refund, rebate or incentive where that particular recall includes that type of fulfillment. Nonetheless, it would have been obvious to one of ordinary skill at the time of the invention to have for example included with the recall notice a rebate for a replacement product, so that the user can properly replace the recalled product.

Regarding claim 13, Knegendorf et al teaches that the system may be implemented with several servers [0039] and it would have been obvious to one of ordinary skill at the time of the invention to have a server dedicated to managing the matching recalls and a server dedicated to delivering the notices. Knegendorf et al also teaches that manufacturers can hire 3rd party fulfillment services [0006] and it would have been obvious to one of ordinary skill at the time of the invention to have forwarded the collection of affected users (i.e. userIDs) to an entity capable of effectively carrying out the fulfillment.

Regarding claim 14, Knegendorf et al teaches that the “manufacturer” can be a retailer [0037], and therefore a system that notifies the manufacturer of users associated with its recall can be said to be a system that notifies a retailer.

Regarding claim 15, it would have been obvious to one of ordinary skill at the time of the invention to have provided the consumer with a form letter customized with his name, userID, etc as is well known. It is also well known to include barcodes with documents so that they may be processed effectively which would have been obvious with that of Knegendorf et al and Abreu so as to effectively track the recall and fulfillment.

Regarding claims 16, 21, it would have been obvious to one of ordinary skill at the time of the invention to have accounted for returns and costs of the recall as businesses are generally accountable for their financial reports as well as reports to industry groups, government, taxation entities, etc. See ¶ 0032. It is only a matter of good business sense to keep track of a businesses financial records and product flow.

Regarding claims 17-19, it would have been obvious to one of ordinary skill at the time of the invention to have entered a userID into a computer upon fulfillment so that the user cannot again try to fraudulently get more free products. It would have been obvious to one of ordinary skill at the time of the invention to have enabled returns of products at the POS as this is a typical place where consumers return merchandise. Official Notice is taken that returning recalled products by mail is a well known means for requesting replacement and it would have been obvious to one of ordinary skill at the time of the invention to have sent and received products via registered mail so that the postal facility can track shipments for better recordkeeping.

Regarding claim 20, 21, Knegendorf et al teaches that it is known to calculate effectiveness of recalls [0006] and it would have been obvious to one of ordinary skill at the time of the invention to have do so with that of Knegendorf et al in view of Abreu. Further, it would have been obvious to one of ordinary skill at the time of the invention to have paid a 3rd party fulfillment service according to how many products they had to process as part of the recall project.

Regarding claims 22, 23, any notice sent to a consumer is taken to be "marketing", even the sending of recall notices. Further however, Knegendorf et al teaches the value in the collected consumer information with such a system [0030, 0034 – "a manufacturer may be able to get a better understanding of its consumers and their interests, and how its products are being used, therefore gaining information that may be used in new product design"]. It would have been obvious to one of ordinary skill at the time of the invention to have sent marketing information to the consumers of

Knegendorf et al so that such "new products" can be marketed to those consumer interested in the types of products. Knegendorf et al also teaches keeping track of which notices a consumer sees and how often they re-visit those messages [0046]. It would have been obvious to one of ordinary skill at the time of the invention to have sent repeat recall notices to unfulfilled consumers, especially where the product defect is a serious or deadly one.

Regarding claims 52-54, 56-58, Knegendorf et al teaches that the computer system may link the consumers to fulfillment companies such as via HTML to fulfillment websites [0092]. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished the well known fulfillment (offer and reconcile a rebate where proof of purchase is shown, or provide/generate/output a discount voucher for a future product purchase) through the automated computers system set forth by Knegendorf et al. In this manner, consumers can be made whole through automated fulfillment – providing fulfillment convenience in the same spirit that Knegendorf et al provides convenient and automated recall notifications.

(10) Response to Argument

Applicant argues that the examiner's taking of Official Notice is inappropriate because it is not "capable of instant and unquestionable demonstration". Examiner is aware of the need for instant and unquestionable demonstration for proper taking of Official Notice. Examiner is also aware that an "adequate traversal" of Official notice must include the applicant "specifically pointing out the supposed errors" including

stating "why the noticed fact is not considered to be common knowledge." Nonetheless examiner has cited a few examples that mention how consumers are made whole for recalled products – refunds, merchandise vouchers, rebates, etc.

Applicant argues that even if vouchers were known, the claim is not met. Applicant argues that claim 3 requires "follow-on marketing" associated with the recall-affected purchasers. This however is not in claim 3. Applicant argues that the officially-noticed facts fail to provide "a terminal of a retail store computer system responding and providing the associated rebate or incentive offer". Again this is not quite the language in the claims. Claim 3 calls for "providing...a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate...and (2) a incentive...discount." Appellant appears to acquiesce to the obviousness of "providing...a notification of said recall for said product". Therefore the rejection must also cover "offering a rebate" or "incentive discount". Offering is taken to merely require informing the consumer that a rebate or incentive discount are available as remedies. The claim is not believed to require execution or redemption acts/functionality. Nonetheless, given that both applied references provide computer systems which automate the heretofore manual recall procedures, it would have been obvious to one of ordinary skill at the time of the invention to have completed/redeemed either of a rebate or voucher discount at the computer terminal in known manners, so as to further provide automated recall fulfillment as desired by both references. KSR guidelines [Federal Register Vol. 72, No 195 – Examination Guidelines for Determining Obviousness Under

35 USC 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*]

- *When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions. "*
- *The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art.*

Simply automating the steps of rebate or voucher processing via the terminal gives just what one would expect from the otherwise manual steps. In other words, there is no enhancement found in the claimed steps/system other than the known advantage of increased speed, increased accuracy, increased convenience and reduction in human resource(s) to perform/provide the claimed steps/functionality. The end result is the same as compared to the manual method.

In the same manner as outlined in rationale F of KSR, it would have been obvious to one of ordinary skill at the time of the invention to have updated the system of Knegendorf et al in view of Abreu with modern automated rebate and/or voucher discount improvements in order to gain the commonly understood benefits of such adaptation. All this would be accomplished with no unpredictable results.

As stated in ***Leapfrog***, "applying modern electronics to older mechanical devices has been commonplace in recent years." ***Leapfrog Enterprises, Inc. v. Fisher-Price***, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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